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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/281,760	03/30/1999	ROBERT LAWTON	241/08	7613

20306 7590 05/19/2003

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CHICAGO, IL 60606

EXAMINER

NOLAN, PATRICK J

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 05/19/2003

37

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/281,760

Applicant(s)  
Lawton et al.

Examiner  
Patrick J. Nolan

Art Unit  
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 10, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6, 8, 15, 21, 27, 34, 41, 43, 116, and 117 is/are pending in the application.
- 4a) Of the above, claim(s) 116 and 117 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 27, 34, 41, and 43 is/are allowed.
- 6) ☒ Claim(s) 8, 15, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 1644

#### DETAILED ACTION

1. The examiner of your application in the PTO have changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Patrick Nolan, Art Unit 1644, Technology Center 1600.

2. Claims 6, 8, 15, 21, 27, 34, 41, 43 and newly added claims 116-117 are pending.

Claims 116-117 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b) as being drawn to non-elected inventions. Claims 116-117 are drawn to antibodies that specifically bind a 71 amino acid sequence. While it is correct that the previously Examined claims are drawn to 7-mer and 11-mer peptides that exist within the 71 amino acid polypeptide, claims 116 and 117 are independent claims and would encompass many antibodies not originally searched when the claims were drawn to antibodies that specifically bind SEQ ID NOS 4 and/or 5. Antibodies that would specifically bind other epitopes within the 71 amino acid polypeptide were not searched at any point during the last office action, since in the last office the antibodies had to specifically bind SEQ ID NOS 4 or 5.

3. Claims 6, 8, 15, 21, 27, 34, 41 and 43 are under consideration in the instant application.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

4. Claims 8, 15 and 21 stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a specific binding protein which specifically binds to SEQ ID NO 4 or 5. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims for the reasons set forth in Paper Nos. 22 and 16, mailed 5/21/2001 and 10/24/2000, respectively, and the reasons set forth below.

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Applicant's arguments set forth in Paper No. 31, received 10-10-02 have been fully considered but are not found persuasive.

Applicant argues the specific binding proteins are to be used diminishing the production of IgE in a dog and that one of skill in the art could make the claimed variants of SEQ ID NO. 4 and 5 and could test and use specific binding proteins that bind to variant peptides.

However, to be useful the antibodies need to be able to bind to an IgE molecule on an B cell or free IgE but not to masct cell bound IgE, Applicant has not demonstrated that any of their variant peptides exist on such IgE bound to B cells or on free IgE. As such what use would the antibodies binding to an unknown, undiscovered, variant peptide be? The ability of the antibody resulting from immunization with the variant to bind the original peptide is unpredictable in view of Coleman et al., and Lederman et al., so what would one of skill in the art due with this antibody?

It is the examiner's opinion that the specification does not enable one of skill in the art to practice the invention as claimed without undue experimentation.

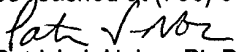
5. Applicant is notified that claims 6, 27, 34, 41 and 43 are found free of the prior art.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Thursday from 9:30 am to 4:30 pm.

8. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7939.

  
Patrick J. Nolan, Ph.D.

Primary Examiner, Group 1640

5/18/03